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10/070,867	03/12/2002	Maria Giuseppina Martini	IT 010006	2617

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05/24/2004

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EXAMINER

WAMSLEY, PATRICK G

ART UNIT

PAPER NUMBER

2819

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Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 05182004

Application Number: 10/070,867
Filing Date: March 12, 2002
Appellants: MARTINI ET AL.

MAILED

MAY 24 2004

Leslie B. Wilson
For Appellant

GROUP 2800

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 04/06/2004.

(1) ***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

(2) ***Related Appeals and Interferences***

A statement indicating that there are no related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-13 should be considered as one claim group.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

3,996,558

HEUN

12-1976

Koenen, Rob. "MPEG-4 Overview - (Dublin Version)" International Organisation for Standardisation, July 1998, pp. 1-55

(10) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claims 1-13 are rejected under 35 U.S.C. 112, ¶1, as failing to comply with the enablement requirement. Claims 1-13 are rejected under 35 U.S.C. §103 (a) as

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unpatentable over Koenen in view of Heun. These rejections are set forth in prior Office Action mailed on 11/05/2003.

(11) Response to Arguments

First, appellant argues that claims 1-13 have been erroneously interpreted. In response, the key question here is how one should interpret the word "single," applied as an adjective to the term "length information field" on line 5 of claim 1, line 4 of claim 6, line 6 of claim 8, line 4 of claim 9, line 7 of claim 10, line 7 of claim 11, lines 3-4 of claim 12, and lines 4-5 of claim 13. The use of a "single" field is not supported by the current specification, as described below.

According to M.P.E.P. 2164.08, the examiner should determine what each claim recites and what the subject matter is when the claim is considered as a whole, not when its parts are analyzed individually. If a reasonable interpretation of the claim is broader than the description in the specification, it is necessary for the examiner to make sure the full scope of the claim is enabled. Here, the issue is whether the specification enables the recited use of a "single" field.

Appellant alleges that Figures 3 and 6 support this limitation. In response, Figure 6 clearly presents three length fields (lf), contrary to appellant's recitation of a single field. The current claims do not limit the "single" field to a particular partition, as the overly broad claims lack such restrictions.

Second, appellant argues that the obviousness rejection should be withdrawn. Specifically, appellant contends that Heun teaches away from a "single" field for a group of partition bodies, instead presenting a partition head [25] for each partition body [31].

In response, the examiner regards appellant's arguments as internally contradictory. For the question of enablement, appellant argues that a "single" information field encompasses partitions grouped within different parts of a data stream wherein each give [sic] part includes its own "single" field. In contrast, appellant argues that the instant invention is patentably distinct from the Koenen / Heun combination because it has a "single" field for a group of partitions. The specification, as described for the enablement rejection above, does not clearly define how length fields are matched to specific data groupings.

One section of the specification highlights the problem of interpreting the "single" field limitation. On lines 17-18 of Page 6, a length field [lf] is added in each packet after the resync marker. The term packet, never used in any of the claims, lacks a specific definition in the disclosure. Moreover, there is no suggestion that the claim language is limited to a "single" field per packet, regardless of how a packet is defined.

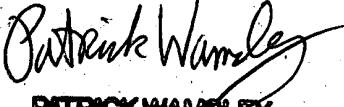
On lines 1-3 of Page 13, the specification describes a special case in which length information is provided in a first packet, but, presumably, does not appear in subsequent packets. However, this case, limited to a situation in which the respective lengths of packets remain constant for an indefinite, undefined period of time, does not correspond to any limitation in the claims. Moreover, no limitations patentably define the instant invention over the Koenen / Heun limitation by clearly claiming the lack of a gap [21] between partition bodies [31].

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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PRIMARY EXAMINER

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May 18, 2004

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